

WorldCom Docket No.: RIC-99-006

Attorney Docket No.: 09710-1058



#3
J. Taylor
1/28/01

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

PORTER ET AL.

SERIAL NO: 09/397,578

FILED: SEPTEMBER 16, 1999

FOR: METHOD AND SYSTEM FOR
NEGOTIATED CALL
FORWARDING

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GROUP ART UNIT: 2642

EXAMINER: BUI, B.

TC 2600 MAILROOM

FEB 26 2001

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RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Restriction Requirement dated November 22, 2000, Applicants elect with traverse Group I, Claims 1-10 and 18-21, directed to a system and method for call forwarding in accordance with approval of forwarding to party. Applicants make this election based on the understanding that Applicants are not prejudiced against filing one or more divisional applications that cover the non-elected claims.

In addition to making this election, Applicants respectfully traverse this Restriction Requirement for the reason that the inventions of Groups I and II have not been shown to be distinct in the manner required by M.P.E.P. §806.05(c).

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Pursuant to M.P.E.P. §806.05(c), to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. The Patent Office must demonstrate that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in other and different relations. When these factors cannot be shown, such inventions are not distinct.

On page 3, item 3, the Office Action with respect to the requirements of M.P.E.P. §806.05(c), merely concludes that “the invention of Group I (call forwarding) does not require the particulars of the invention of Group II (video conference)” without explanation. Applicants respectfully submit that this is in contravention of M.P.E.P. §806.05(c). Further, the Office Action states in generalities that the claims of Group I have separate utility from that of Group II.

Since the Restriction Requirement fails to set forth that the combination does not require the particulars of the subcombination as claimed for patentability, it cannot be said to have met the requirement of MPEP §806.05(c).

Moreover, Applicants believe that the conclusory statements of the Office Action are in violation of MPEP §816, which states:

MPEP §816

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. ...

In the absence of any annunciated basis, it is respectfully submitted that the Patent Office clearly has not carried forward its burden of proof to establish distinctness.

Finally, MPEP § 803 states:

MPEP § 803

... If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

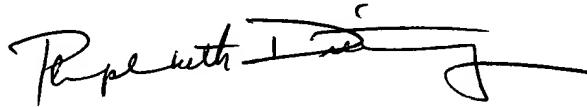
The claims of the present invention would appear to be part of an overlapping search area.

Accordingly, Applicants respectfully also traverse the outstanding Election requirement on the grounds that a search and examination of the entire application would not place a serious burden on the Patent Office.

Therefore, it is respectfully requested that the restriction requirement be withdrawn, and that a full examination on the merits of Claims 1-21 be conducted.

Respectfully submitted,


DITTHAVONG & CARLSON, P.C.

A handwritten signature in black ink, appearing to read "Phouphanomketh Ditthavong", with a long horizontal flourish extending to the right.

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AMENDMENT TRANSMITTAL LETTER			Attorney Docket No.: 09710-1058 Worldcom Docket No.: RIC-99-006				
Application Serial Number: 09/397,578		Filing Date: September 16, 1999		Examiner: Bui, B.		Group Art Unit: 2642	
Invention: METHOD AND SYSTEM FOR NEGOTIATED CALL FORWARDING							
DIRECTOR OF PATENTS AND TRADEMARKS, Washington, DC 20231 <i>Transmitted herewith is an amendment in the above-identified application.</i> The fee has been calculated as shown below.							
CLAIMS AS AMENDED							
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	NO. OF EXTRA CLAIMS PRESENT	RATE	RECEIVED OIP TC 2600 FEB 28 2001 JCA73266 PATENT & TRADEMARK MAIL ROOM ADDITIONAL FEE	
TOTAL CLAIMS	21	MINUS	21	0	\$18	\$ 0.00	
INDEP. CLAIMS	3	MINUS	3	0	\$80	\$ 0.00	
<input checked="" type="checkbox"/> Petition is hereby made under 37 CFR 1.136(a) to extend the time for response to the Office Action of <u>November 22, 2000</u> to and through <u>February 20, 2001</u> , for an extension of the shortened statutory period of: <input type="checkbox"/> One month (\$110) <input checked="" type="checkbox"/> Two months (\$390) <input type="checkbox"/> Three months (\$890) <input type="checkbox"/> Four months (\$1390)							
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$390.00	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. <input type="checkbox"/> A check in the amount of \$ ___ is attached. <input type="checkbox"/> Charge \$ ___ to Deposit Account _____. The Director is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment to Deposit Account _____, including any filing fees under 37 CFR 1.16 for presentation of extra claims and any patent application processing fees user 37 CFR 1.17 <input checked="" type="checkbox"/> Payment of \$ <u>390.00</u> by credit card. Form PTO-2038 is attached. <input type="checkbox"/> No additional fee is required.							
<u>February 20, 2001</u> Date			 Phouphanomketh Ditthavong Reg. No. 44658				
I hereby certify that this correspondence and all correspondence identified as accompanying this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on <u>February 20, 2001</u> .							
_____, Date:							